

REMARKS

Claims 1-58 are pending. Claims 4 and 5 have been indicated to recite allowable subject matter. New claims 7-58 have been added to recite additional features of Applicant's invention.

Reconsideration of the application is respectfully requested for the following reasons.

In the Office Action, the Examiner rejected claims 1-3 and 6 under 35 U.S.C. §103(a) for being obvious in view of a combination formed between the Fujimori patent and the Emori publication. Applicant traverse this rejection for the following reasons.

As discussed in the Background of the Invention section of the specification, a user may adjust one or more parameters of monitor (size, position, pin cushion, etc.) using what is referred to as an on-screen display (OSD). An OSD typically displays a numeral value and/or bar which provides an indication of a degree to which a screen parameter has been adjusted based on user input information. When used by themselves, OSDs have proven to be less than optimum. More specifically, as discussed on pages 2 and 3 of the specification, the results of a screen adjustment made by a user may not be readily apparent and thus may differ from a result the user desired to obtain: "the actual picture is not clearly distinguished from the entire region of the picture" when a screen adjustment is made using the OSD. "Thus, the picture adjustment result cannot be easily viewed on the picture, thereby posing a problem of failing to perform a picture adjustment as desired by the user."

Applicant's invention overcomes these drawbacks by displaying a guideline which may be used, for example, to provide a clear visual indication of the results obtained by a picture adjustment designated by a user. In accordance with at least one embodiment, the guideline is

displayed with an OSD on the display screen. The invention therefore allows a user to view, for example, a statistical indication of a desired parameter adjustment using the OSD and at the same time a visual confirmation of the results of that adjustment provided by the guideline. Thus, by providing a guideline of this type, the user may be assured of making more accurate screen adjustments using fewer adjustment steps. Features which allow these and/or other benefits and advantages of the invention to be realized are recited in the claims.

Claim 1 recites an apparatus for displaying a guideline for picture adjustment in association with an OSD on a display monitor. The apparatus includes:

- 1) "guideline information providing section . . . for generating the guideline . . . and outputting information related to forming the guideline,
- 2) "an image signal generator for receiving information related to forming the guideline from the guideline information providing section, and outputting an image signal to construct a picture including the guideline corresponding to the information related to the guideline,"
- 3) "an image amplifying section for combining the image signal including the guideline outputted from the image signal generator with the OSD image signal outputted from the OSD generating section."

In order to establish a *prima facie* case of obviousness for claim 1, two requirements must be satisfied. First, the cited references must teach or suggest all the features in claim 1. Second, there must have been some teaching or suggestion in existence at the time the claimed invention was made that would have led one of ordinary skill in the art to combine the references in an

attempt to form the invention. See MPEP §2143.01 and *In re Rouffet*, 47 USPQ.2d 1459 (Fed. Cir. 1997). None of the cited references satisfy this test.

The Fujimori patent discloses a video monitor which displays an OSD to show adjustments made by a user to one or more screen parameters. As acknowledged by the Examiner in the Office Action, the Fujimori patent does not teach or suggest displaying a guideline in association with an OSD on its monitor and thus fails to teach or suggest at least features 1) - 3) of claim 1 outlined above.

To make up for these deficiencies, the Emori publication was cited. Emori discloses a method for adding a border or frame around a picture displayed on a computer monitor.

To render claim 1 obvious, the Emori publication must teach or suggest displaying a guideline in association with an OSD on a display device. The Emori publication does not provide a teaching or suggestion of this type. More specifically, Emori does not teach or suggest adding a border or frame around an OSD as required by claim 1, but rather around an "input picture" which, for example, corresponds to the image of a person as shown in Figures 3(a)-(c). From its summary and figures, it is therefore clear that the method disclosed in the Emori publication is directed towards generating a frame or border around a picture of a type which, for example, is downloaded to a computer from a digital camera or captured from the Internet. The Emori publication does not teach or suggest placing a border, frame, or any other type of guideline around an OSD and therefore it is submitted that any combination formed between the Fujimori patent and Emori publication would fail to include at least the "guideline information providing section," "an image signal generator," and "image amplifying section"

recited in claim 1 and outlined in 1) - 3) above. Absent these features, it is respectfully submitted that a Fujimori-Emori combination cannot render claim 1 or any of its dependent claims obvious.

Incidentally, in the Office Action the Examiner alleged that it would have been "well known" to add a border or frame around an OSD and that therefore one of ordinary skill in the art would have been motivated to combine the Fujimori patent and the Emori publication to achieve the claimed invention. Applicant respectfully disagrees.

MPEP §2144.03 states that features may be taken as being "well known" only if they are "capable of instant and unquestionable demonstration as being well known in the art." The Emori publication cited by the Examiner discloses placing a border around a picture displayed on a computer monitor. Emori does not teach or suggest placing a guideline specifically in association with an OSD as recited in claim 1, and neither does any other reference of record. Applicant therefore submits that the record demonstrates that it was not capable of instant and unquestionable demonstration as being well known in the art to display a guideline in association with an OSD. If such knowledge was in existence at the time the claimed invention was made, the Examiner is challenged to produce such a reference showing this to be so. If such a reference cannot be provided, it is submitted that withdrawal of the rejection is proper in accordance with the provisions of MPEP §2144.03.

As further evidence of the non-obviousness of claim 1, Applicant reminds the Examiner that the "obvious to try" standard is not the proper standard for determining obviousness under 35 U.S.C. §103(a). MPEP §2143.01. That is, the Examiner's allegation that it might have been

obvious to try to place a border around an OSD is by itself insufficient to establish the obviousness of claim 1. Rather, the MPEP and Federal Circuit both agree that a specific teaching or suggestion must have been in existence at the time the claimed invention was made that would have led one of ordinary skill in the art to combine a guideline and an OSD. Otherwise, the combination must be considered to be impermissible for purposes of satisfying the §103(a) standard.

The MPEP further makes clear that it is insufficient to prove obviousness merely on the basis that it may have been capable to enclose the OSD disclosed in the Fujimori patent with the frame disclosed in the Emori. Rather, in order to satisfy the requirements of establishing a *prima facie* case of obviousness the Examiner must cite a reference to show that some teaching or suggestion was in existence at the time the claimed invention was made that would have specifically led one of ordinary skill in the art to generate a guideline around an OSD as disclosed in Fujimori. Absent such a teaching or suggestion, it is respectfully submitted that the rejection is improper as a matter of law.

In summary, Applicant respectfully submits that claim 1 and its dependent claims are non-obvious and thus patentable over a Fujimori-Emori combination because no teaching or suggestion was in existence at the time the claimed invention was made to combine these references in the manner proposed by the Examiner. Moreover, even if such a teaching or suggestion was in existence, the resulting combination would at best form a display monitor which generates a border or frame around a picture and not an OSD as recited in claim 1. Allowance of claim 1 and its dependent claims is therefore respectfully requested.

Claim 3 and 6 recite apparatuses which also display a guideline in association with an OSD. For at least the foregoing reasons, it is submitted that these claims are also allowable.

New claims 7-58 have been added to recite additional features of the invention, none of which are taught or suggested by the references of record whether taken alone or in combination.

Reconsideration and withdrawal of all the rejections and objections made by the Examiner is hereby respectfully requested.

In view of the foregoing amendments and remarks, it is respectfully submitted that the application is in condition for allowance. If the Examiner believes that any additional changes would place the application in better condition for allowance, the Examiner is invited to contact the undersigned attorney, Samuel W. Ntiros, at the telephone number listed below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this, concurrent and future replies, including extension of time fees, to Deposit Account 16-0607 and please credit any excess fees to such deposit account.

Respectfully submitted,
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